

## **REMARKS**

By this Amendment, claims 15, 33, 38, 41, 42, and 44 have been amended, and new claims 45-48 have been added. Consequently, claims 15-48 are pending in this application with claims 15, 33, 35, 38, and 41-44 being independent. Support for the new claims can be found in the originally filed specification, drawings, and claims.

As an initial matter, Applicant wishes to express sincere appreciation to the Examiner for the courtesy extended to Applicant's representative during the personal interview held on November 1, 2005. At the interview, various rejections outstanding in the July 26, 2005 Office Action were discussed in detail. The following remarks reflect subject matter discussed during the interview.

Applicant also takes this opportunity to thank the Examiner for indicating that claim 16 contains allowable subject matter.

For the following reasons, Applicant respectfully requests withdrawal of all the rejections outstanding in the July 26, 2005 Office Action and allowance of all the pending claims.

In the Office Action, claims 15, 17-22, 25, 26, 28, 29, 31-34, 38-42, and 44 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,840,288 to Lunderman et al. ("Lunderman"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

During the interview, Applicant's representative proposed amendments to independent claims 15, 33, 38, 41, 42, and 44 that are substantially the same as those above. In response, the Examiner indicated that those amendments would likely overcome the outstanding rejections. See Interview Summary dated November 1, 2005. Therefore, without necessarily acquiescing to the rejection, Applicant presented

the foregoing amendments to further distinguish the claims from Lunderman. For at least this reason, independent claims 15, 33, 38, 41, 42, and 44, and their respective dependent claims, patentably distinguish from Lunderman. Thus, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection based on Lunderman.

Claims 23, 24, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lunderman. Each of claims 23, 24, and 27 depends from independent claim 15. As discussed above, claim 15 patentably distinguishes from Lunderman. Therefore, these claims should also patentably distinguish from Lunderman at least by virtue of their dependency from independent claim 15. Thus, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection based on Lunderman.

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lunderman in view of U.S. Patent No. 4,863,034 to Contreras, Sr. (Contreras). Claim 30 depends from independent claim 15. As discussed above, claim 15 patentably distinguishes from Lunderman. Contreras also does not supply the deficiencies of Lunderman. Therefore, claim 30 should also patentably distinguish from Lunderman at least by virtue of its dependency from independent claim 15. Thus, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection based on the asserted combination of Lunderman and Contreras.

Claims 35-37 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lunderman. Applicant respectfully traverses this rejection.

Independent claim 35 recites, among other things, “a base defining at least one housing configured to contain a product, the base including a first catch member,” “an intermediate element ... including a second catch member configured to mate with the first catch member to lock the intermediate element to the base,” and “a lid articulated on the base via the intermediate element,” “wherein the base defines a lateral wall being delimited by both a first edge adjacent the lid when the lid is in a closed position relative to the base and a second edge opposite the first edge,” and “wherein the intermediate element rotates with respect to the base about an articulation axis arranged substantially at the second edge.” Independent claim 43 includes substantially similar subject matter as that of claim 35, except that the recitations “first catch member” and “second catch member” are replaced with “first means for catching” and “second means for catching.”

While admitting that Lunderman lacks disclosure of “the articulation axis of the intermediate element and the base being located substantially at the second edge of the lateral wall,” the Office Action asserted that, citing In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), “it would have been obvious to form the hinges, whether living or articulating, and the corresponding articulation axis at the second edge of the lateral wall, since it has been held that mere relocation of parts of an invention involves only routine skill in the art.” Applicant respectfully disagrees with this assertion.

The Patent Office has the initial burden of presenting a *prima facie* case of unpatentability. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion

or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143. As detailed below, Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

In particular, without providing any plausible explanation or reasoning regarding those basic criteria for establishing a *prima facie* case, the Office Action merely relies on Japikse for the general proposition that “mere relocation of parts of an invention involves only routine skill in the art.” Applicant’s representative has reviewed that decision and found no such generalized proposition or rule of law. Indeed, the Board of Patent Appeals and Interferences has made it clear that Japikse should be limited to the facts of that case (i.e., the missing subject matter relating to the position of the starting switch is immaterial and the overall operation of the device would not be affected by the position change). Ex parte Robles, 1997 WL 1883840 (Bd. Pat. App. & Interf.)<sup>1</sup>. Moreover, the Board has expressly rejected application of Japikse as a per se rule of obviousness and held that reliance on Japikse to establish obviousness under 35 U.S.C. § 103(a), without supplying a factual basis, is improper. See Ex parte Makutonin, 2003 WL 23014547 (Bd. Pat. App. & Interf.)<sup>2</sup>.

Furthermore, even assuming, *arguendo*, that Japikse stands for the general proposition alleged by the Office Action, the Office Action still has not established a

---

<sup>1</sup> The Board noted that this opinion was not written for publication in a law journal and is not binding precedent of the Board.

<sup>2</sup> The Board noted that this opinion was not written for publication.

*prima facie* case of obviousness because the Office Action did not provide any factual basis to support the allegation that the recited position of the articulation axis (i.e., “the articulation axis of the intermediate element and the base being located substantially at the second edge of the lateral wall”) is nothing more than a “mere relocation of parts” from Lunderman.

As is well-settled, a rejection based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-178 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In this case, the Office Action is doing exactly that. When Lunderman is viewed without such speculation, unfounded assumptions, or hindsight gleaned from the present application, the alleged modification would not be suggested since there is no suggestion or motivation to do so. Moreover, the recited position of the articulation axis involves more than a “mere relocations of parts” from Lunderman. For example, referring to Fig. 2 of Lunderman, it is more than likely that repositioning of the hinge pin 34 to a location “substantially at the second edge of the lateral wall axis of the base,” if such repositioning is at all possible, would also require, among other things, adjusting the length of the link 30 and repositioning of the latches 40, 42, 44 along the link 30, etc. all of which are more than “mere relocations of parts.”

For at least the reasons set forth above, Applicant respectfully submits that independent claims 35 and 43, and claims 36 and 37 depending from independent

claim 35, patentably distinguish from Lunderman. Thus, Applicant respectfully requests reconsideration and withdrawal of this 35 U.S.C. § 103(a) rejection based on Lunderman.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application, the withdrawal of all the outstanding rejections, and the allowance of all pending claims 15-48.

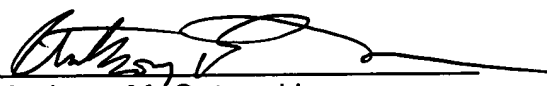
The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 22, 2005

By:   
Anthony M. Gutowski  
Reg. No. 38,742